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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/644,560	08/24/2000	Patrick A. Forte	A7809	2556
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Sughrue Mion Zinn MacPeak & Seas PLLC 2100 Pennsylvania Avenue N W Washington, DC 20037-3213			EXAMINER GREENE, DANIEL L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/644,560

Applicant(s)

FORTE, PATRICK A.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. In view of the BRIEF ON APPEAL filed on 5/26/2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Taylor U.S. Patent 5,578,808 [Taylor].**

4.

As per claim 20:

Taylor discloses:

means allowing a customer to access his individual program account, the individual program account being an account representing an array of accounts that have been individually selected by the customer from the totality of the accounts and including at least one stored value account for a merchant; Col. 3, lines 20-54.

a host processor for executing transaction instructions and maintaining individual program account information, said host processor including a database for maintaining individual program account transactions and records; Col. 4, lines 5-45.

means for establishing and maintaining a plurality of customer individual program accounts; Col. 5, lines 10-50.

means to support of a customers' transactional interchange of individual program account including access to a stored value account having been pre-authorized by a customer to settle transactions. Col. 5, lines 5-40.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21- 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor as applied to claim 20 above, and further in view of Davis et al. U.S. Patent 6,282,522 [Davis].

As per claim 21:

Taylor discloses the claimed invention except for a plurality of stored value accounts maintained by a merchant for a plurality of customers each having an individual program account. However, Taylor does teach about the use of the card for doing transactions with companies other than a credit card company. Col. 4, lines 44-50. Taylor further illustrates in Fig. 1, multi-card records accessible for use including oil and hotel and airline merchants. Davies teaches that it is known in the art to provide a plurality of stored value accounts maintained by a merchant for a plurality of customers each having an individual program account. Col. 8, lines 20-36. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the multi- card/merchant accessibility of Taylor, to include one of the companies/merchants describe in Davies that offers the capability of functioning as a payment server at its own site and providing the convenience of on site banking functions at the companies/merchants site.

As per claim 22:

Taylor discloses the claimed invention except for a plurality of demand deposit accounts maintained by a plurality of customers in a federally insured banks as a component of an individual program account. It would have been

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obvious to one having ordinary skill in the art at the time of the invention was made to have a plurality of demand deposit accounts maintained by a plurality of customers in a federally insured banks as a component of an individual program account, .since it is known in the art that a smart card can be used for transactions involving not only banks but as Taylor teaches, a variety of commercial accounts i.e. VISA, oil co, hotels, etc.

As per claim 23:

Taylor discloses a multi-application data card, which is capable of substituting for a plurality of existing single application data cards. The examiner takes Official Notice that a common data card can be a merchant card i.e. Sears, Hecht's, etc. Davis discloses that a merchant can implement payment server functionality which as taught, provides all the functions associated with banking functions i.e. funds transfer in and out. Col. 8, lines 20-36.

It would have been obvious to one having ordinary skill in the art at the time of the invention to have included as one of the data cards, a merchant card that provided the capability of financial transactions because the skilled artisan would have recognized that this business practice of providing financial transactions at a point of sale provides convenience and added value to their service to the customer and is clearly applicable to one of Taylor's accounts that a merchant can implement payment server functionality which as taught by Davis, provides all the functions associated with banking functions i.e. funds transfer in and out. These advantages are well known to those skilled in the art.

As per claim 24:

Taylor further discloses:

means to support an array of mechanisms by which customers may convert value from one account in their individual program account to another account in the same individual program account. Fig. 7-8.

As per claim 25:

Taylor and Davis discloses the claimed invention except for means enabling said merchant to utilize point of sale terminals to access services to verify a check presented by a customer to the merchant. However, Taylor, as per fig. 7-8, teaches about electronic funds transfer. Fig. 7, **202** - Fig. 8, **218** . It would have been obvious to one having ordinary skill in the art at the time of the invention was made to enable said merchant to utilize point of sale terminals to access services to verify a check presented by a customer to the merchant. since it is known in the art that verification of a check entails the same procedure as authorization of a card .

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As per claim 26:

Taylor further discloses:

means for establishing a merchant demand deposit account and providing said merchant access to that same merchant demand deposit account. Col. 5, lines 50-65.

As per claim 27:

Taylor further discloses:

means enabling said merchant to credit to a customer's stored value account by an amount based on the value of a negotiable instrument presented to the merchant by the customer. Col. 8, lines 1-67.

As per claim 28:

Taylor further discloses:

means enabling a customer to access their stored value account to credit or debit other accounts in their individual program account. Fig. 3.

As per claim 29:

Taylor further discloses:

means enabling a customer to utilize the value in the customer's stored value account and instruct the merchant to credit the customer's demand deposit

account at a bank with funds from said merchant's demand deposit account. Col. 7-8, lines 1-67.

As per claim 30:

Taylor does not expressly show establishing a customer individual program account which includes at least one customer stored value account, establishing a customer demand deposit account, establishing a merchant stored value account, and executing a transaction between said consumer and said merchant affecting the account balances in said customer stored value account, said customer demand deposit account and said merchant's stored value account.

However Taylor does show a plurality of customer individual program accounts called VISA, AIRLINES, HOTEL, etc. Any of these accounts could be a stored value account, a demand deposit account, etc. Also, these accounts, as shown by Taylor can be interactive as per Fig. 7-8.

So, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The executing a transaction step would be performed the same regardless of the type of name given to an account. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to establishing a customer individual program account which includes at least one customer stored value account, establishing a customer demand deposit account, establishing a merchant stored value account, and executing a transaction between said consumer and said merchant affecting the account balances in said customer stored value account, said customer demand deposit account and said merchant's stored value account because what an account is called does not functionally relate to the steps in the method claimed and because the subjective interpretation of an account does not patentably distinguish the claimed invention.

As per claim 31:

Taylor discloses the claimed invention except for the step of pre-approving withdrawals from either a customer stored value account or a customer demand deposit account. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to the step of pre-approving withdrawals from either a customer stored value account or a customer demand deposit account. since it is known in the art that Card Authorization prior to transferring value as per steps **221** and **214**, Fig. 8, is the same as pre-approval.

As per claim 32:

Taylor further discloses:

the step of establishing accounts within said individual program account.

Fig. 1.

As per claim 33:

Taylor discloses the claimed invention except for the step of executing a transaction comprising the step of presenting a negotiable instrument at a point of sale at said merchant, to credit or debit account balances. Davis teaches that it is known in the art to provide the step of executing a transaction comprising the step of presenting a negotiable instrument at a point of sale at said merchant, to credit or debit account balances. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the accounts of Taylor with the step of executing a transaction comprising the step of presenting a negotiable instrument at a point of sale at said merchant, to credit or debit account balances of Davis in order to provide convenience to the customer for conducting transactions with a merchant.

As per claim 34:

Taylor further discloses:

the step of providing customer access to the customer demand deposit account and said customer individual program account accounts to convert balances from one account to another account. Fig. 3-4.

As per claim 35:

Taylor further discloses:

the step of providing merchant access to the merchant stored value account to convert a balance to said customer demand deposit account. Fig. 7-8.

As per claim 36:

Taylor discloses the claimed invention except for the step of establishing a merchant demand deposit account. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to the step of establishing a merchant demand deposit account,. since it is known in the art that in order to have a TYPICAL APPLICATION RECORD, as per Fig. 4, the step of establishing a merchant demand deposit account would have to of been done.

As per claim 37:

Taylor does not expressly show the step of converting a balance from said merchant demand deposit account to said customer demand deposit account. Taylor does show as per Fig. 7-8 transferring funds between accounts. The Examiner submits that a credit card could represent demand deposit accounts.

So, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The executing a transaction step would be performed the same regardless of the type of name given to an account. Thus, this descriptive material will not distinguish the

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claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to the step of converting a balance from said merchant demand deposit account to said customer demand deposit account, because what an account is called does not functionally relate to the steps in the method claimed and because the subjective interpretation of an account does not patentably distinguish the claimed invention.

As per claim 38:

Taylor does not expressly show that what is presented is a negotiable instrument. Taylor does teach about ELECTRONIC FUNDS TRANSFER. The Examiner submits that to accomplish an electronic funds transfer, a virtual negotiable instrument is utilized. Also, a debit card is a negotiable instrument and/or represents a negotiable instrument. As presented previously, Davis shows where a merchant account can act as a PAYMENT SERVER with all the functions of a PAYMENT SERVER.

Therefore, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of said customer presenting a negotiable instrument at a point of sale at said merchant, acceptance of the negotiable instrument by the merchant, crediting a corresponding value corresponding to the negotiable instrument to the

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customer SVA and paying for the purchase of goods from said merchant. steps would be performed the same regardless of the type of negotiable instrument presented be it actual, representative form or virtual. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the steps of said customer presenting a negotiable instrument at a point of sale at said merchant, acceptance of the negotiable instrument by the merchant, crediting a corresponding value corresponding to the negotiable instrument to the customer SVA and paying for the purchase of goods from said merchant because the type or representation there of does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially

teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/4/2004

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